

## **REMARKS**

### **I. Claims**

Claims 1-10 are currently pending and stand rejected. By way of this Response, Claim 1 has been amended. No new matter is presented by way of this amendment. Support for the amendment can be found throughout the specification, including at page 3, lines 7-9 of the Specification.

### **II. Summary of the July 8, 2008 Office Action**

In the July 8, 2008 Office Action, the Office set forth the following rejections:

- (a) Claims 1, 5, 6, 9, and 10 were rejected under 35 § U.S.C. 102 (a) or (e) as being anticipated by U.S. Patent No. 6,364,143 (“Knierbein”);
- (b) Claims 2-4 were rejected under 35 § U.S.C. 103(a) over Knierbein in view of U.S. Patent No. 5,494,170 (“Burns”); and
- (c) Claims 7 and 8 were rejected under 35 § U.S.C. 103(a) over Knierbein in view of U.S. Patent No. D456,507 (“LeMarr”).

### **III. The Rejection Under 35 U.S.C. § 102 Over Knierbein Should Be Withdrawn.**

The Office rejected Claims 1, 5, 6, 9, and 10 as anticipated under 35 U.S.C. § 102 over Knierbein. To establish anticipation, the Federal Circuit has stated that it “requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *see also* MPEP § 2131. It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Furthermore, “[t]he identical invention must be shown in as complete detail as contained in the...claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Applicant respectfully submits that a case for anticipation has not been established as Knierbein fails to disclose each and every element of Claim 1. As amended, Claim 1 is directed

to a container comprising an elastically deformable pinching-off part with a noncircular cross-section, wherein the pinching-off part assumes its original shape after pinching.

Initially, the Applicant respectfully disagrees with the Office's assertion that the term "elastically deformable" has not been given a special meaning. The Applicant directs the Office to page 3, lines 4-9 and to page 6, lines 10-14 of the Specification. These citations show that the elastically deformable part has been defined as one which is able to be clamped with relatively slight pressures, irrespective of the material used, will re-assume its original shape after pinching and will not break when it is pressed together.

In contrast, the connector described in Knierbein is both circular and not elastically deformable such that it can be pinched with a slight amount of pressure or that it re-assumes its original shape after being pinched. Nothing within Knierbein indicates that it comprises a connecting part that is elastically deformable with relatively slight pressure or that it would re-assume its original shape after being deformed. In fact, the claim language contained in Knierbein suggests that the connecting part may only be deformed with heat. The barrier part of Knierbein, which includes the connecting part and is formed via injection molding, is comprised of a material of which the base body is also comprised. *See* Knierbein Claim 1. In addition, the material making up the envelope of the barrier module includes either polyolefine or polypropylene. *See* Knierbein Claims 10 and 11. As such, the base body connector comprises either polyolefine or polypropylene.

It is well known to a person of ordinary skill in the art that polyolefine or polypropylene are only deformable with pressure when the material is very thin, such as foil. In contrast, when used in the dimensions disclosed in Knierbein, both polyolefine and polypropylene are thermoplastic plastic materials that are only deformable upon heating. Therefore, the connecting part disclosed in Knierbein cannot be deformed simply by applying pressure. Likewise, the connecting part, once deformed, will not automatically re-assume its original shape; rather, it would appear that the connecting part would need to be remolded into its original shape after being heated and deformed.

Further, although not expressly limited to a circular tubular section, the figures of Knierbein demonstrate that the tubular section was intended to be circular. In particular, Figure 2 of Knierbein, illustrating the top view of the tubular section, demonstrates that the cross section is circular. Moreover, none of the other illustrations of Knierbein illustrate a non-circular cross

section. In contrast, as illustrated in Figure 5 of the pending application, it clear that the Applicant teaches a connecting part that has a non-circular cross section.

Moreover, as previously set forth by the Applicant, the method of connection disclosed in Knierbein limits it to having a circular cross section that is not elastically deformable. Specifically, Knierbein comprises a connector with a tubular upper part with an external threading for screwing onto a coupler nut. (Knierbein 3:41-43.) In order to be able to be screwed into the coupler nut and form a seal, as described in Knierbein, the upper tubular part cannot be elastically deformable. If the upper tubular part were deformable with slight pressure, it would be incapable of forming the seal as claimed in Knierbein. (See Knierbein Claim 1.) Similarly, the connection of the external threading and a coupler nut would not result in the claimed seal of Knierbein, if the connection part is non-circular in cross section. Rather, only with a circular cross section would the threads of the tubular portion of the connecting part be able to spin in an inter-locking fashion with the coupler nut, such that the claimed seal in Knierbein would be formed.

Based on the foregoing, the Applicant respectfully submits that Knierbein fails to disclose each and every element of independent Claim 1. Claims 5, 6, 9, and 10 depend from independent Claim 1. Therefore, Knierbein does not anticipate Claims 5, 6, 9, and 10. As such, Applicant respectfully requests the rejection under 35 U.S.C. § 102 based upon Knierbein be withdrawn.

#### **IV. The Rejections Under 35 U.S.C. § 103 Should Be Withdrawn.**

The Office rejected dependent Claims 2-4, which depend from independent Claim 1, as obvious under 35 U.S.C. § 103 over Knierbein in view of Burns. The Office also rejected dependent Claims 7 and 8, which depend from independent Claim 1, as obvious under 35 U.S.C. § 103 over Knierbein in view of LeMarr. The Applicant respectfully submits that no *prima facie* case of obviousness has been established because the Office has not demonstrated that the references, regardless if combined, teach or suggest all of the limitations of the claimed invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. M.P.E.P. § 2143. First, there must an apparent reason why a person of ordinary skill would have combined the prior art elements in the manner claimed. *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct.

1727, 1741 (2007). Second, there must be a reasonable expectation of success. *See* Exam. Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of *KSR Int'l Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57530 (Oct. 10, 2007). Third, the references, when combined, must teach or suggest all the claim limitations or the Office must explain why the shortcomings of the prior art would have been obvious. *Id.* at 57528.

The burden of establishing a *prima facie* case of obviousness lies with the PTO. In determining obviousness, one must focus on the invention as a whole. *Symbol Technologies Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1577-78, 19 U.S.P.Q. 2d 1241 (Fed. Cir. 1991). The primary inquiry is: “[w]hether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success ... Both the suggestion and the expectation of success must be found in the prior art, not the applicant’s disclosure.” *In re Dow Chemical*, 837 F.2d 469, 473, 5 U.S.P.Q. 2d 1531 (Fed. Cir. 1988).

In addition to its discussion on Knierbein, the Office submits that Burns discloses a snap fit and a self-sealing membrane. The Office also submits that LeMarr discloses a nebulizer vial comprising an arrow designed as a recess and/or as a raised structure that shows the user where the fluid will exit the container when opened. Finally, the Office submits that it would have been obvious for one of ordinary skill in the art to combine the teachings of Knierbein with Burns or LeMarr.

As previously discussed, Knierbein fails to teach or suggest each and every element of independent Claim 1. Specifically, Knierbein fails to disclose a connecting part which has a non-circular cross section and is elastically deformable, such that it may be pinched with minimal force and will thereafter re-assume its original shape after the pressure has been released. Burns and LeMarr both fail to disclose this limitation of Claim 1 in the pending application. As such, one of ordinary skill in the art, when reading Knierbein in view of LeMarr or Burns would not be taught or suggested to develop a connecting part that was non-circular, elastically deformable with minimal pressure and re-assumed its original shape after pinching. Therefore, even if LeMarr, Burns and Knierbein were combinable, which the Applicant denies, such a combination fails to teach or suggest all the elements of independent Claim 1, upon which Claims 2 through 4 and Claims 7 and 8 depend.

Moreover, the use of the non-circular, elastically deformable connecting part has benefits not contemplated in Burns or LeMarr. The elastic deformability of the connecting part eliminates the danger of liquid escaping the packaging after filling. (*See Appl.* at 2:33-37.) In addition, the elastic deformability of the connect part allows the packaging to filled in a horizontal position, which is particularly useful when large-volume bags are filled. (*Id.* at 3:1-4.)

Based on the above, the Applicant respectfully requests that the Office's rejection of Claims 2-4 as obvious under 35 U.S.C. § 103(a) over Knierbein in view of Burns be withdrawn. The Applicant similarly respectfully requests that the Office's rejection of Claims 7 and 8 as obvious over Knierbein in view of LeMarr be withdrawn.

### **CONCLUSION**

For at least the foregoing reasons, it is respectfully submitted that Claims 1-10 are in condition for allowance. Early and favorable consideration is respectfully requested, and the Examiner is encouraged to contact the undersigned with any questions or to otherwise expedite prosecution.

Further, none of Applicant's amendments or cancellations are to be construed as dedicating any such subject matter to the public, and Applicant reserves all rights to pursue any such subject matter in this or a related patent application.

Respectfully submitted,

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